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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,452	10/27/2003	Jason C. Birnholz	28,449-A	2914

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EXAMINER

SIRMONS, KEVIN C

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,452

Applicant(s)

BIRNHOLZ, JASON C.

Examiner

Kevin C. Sirmons

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Benjamin U.S. Pat. No. 3,146,920.

As to claim 7, Benjamin discloses a device for a medicament over the surface of an internal body cavity comprising: a generally cylindrical hollow main body (fig. 1), said body having an open upper end (figs. 2 and 3), a manually-operated pump communicating with said body (13), said pump including a manually reciprocating member having a laterally-oriented nozzle (figs. 1-3), said manually-reciprocating member being axially fixed relative to said body (fig. 3); at least a portion of said device being insertable into said cavity following which operation of said pump causes dispensing of said medicament over a laterally-directed path upon rotation of said body (figs. 1-3).

Claims 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Throop U.S. No. 1,878,026.

Throop discloses a method of applying a medicament to the surface of a body cavity comprising the steps of: providing a container for said medicament having a

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laterally oriented nozzle, and integral means for expelling said medicament through said nozzle (fig. 1 and 2); inserting said nozzle into said cavity (vaginal cavity, col. 1) and operating said device for expelling said medicament while simultaneously rotating said nozzle through and arcuate path of movement to evenly coat said surface (figs. 1 and 2);

As to claim 5, Throop discloses a single use device for applying a fluid medicament to an internal genital areas comprising: a hollow elongated flexible body forming a cavity (figs. 1 and 2); said body having an end portion forming an open neck (curved portion of and/or around 11), a hollow tube (8) interconnected to said neck having a manually frangible sealed terminal (9), said tube extending laterally of said neck (figs. 1 and 2); as to claim 6, (Claim 6 is a product-by-process claim which has been given little patentable weight because patentability does not rely on the method of making (fig. 1 and 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin
U.S. Pat. No. 3,146,920.

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Benjamin discloses the method substantially as claimed except for inserting said nozzle into the cavity and simultaneously rotating said nozzle through an arcuate path of movement to evenly coat said surface. Benjamin's device is structurally equivalent to applicant's device and it is the examiner position that it natural to rotate the nozzle of a device to evenly flush, clean, or disperse medicament for cleaning or medical purposes. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize applicant's broad method steps with the device as taught by Benjamin for cleaning and/or medicating a body cavity.

Response to Arguments

Applicant's arguments filed 12/17/04 have been fully considered but they are not persuasive.

Throop discloses a single used device for applying a fluid medicament to an internal genital areas having an integral body including part of the body which is flexible, the body having a frangible sealed, laterally extending tube which is curved for rotating and distribution of medicament over a continuous arcuate path. The body is clearly squeezed to allow the medicament to be dispersed. It is without a doubt the perfect size to be inserted within an internal genital area as taught by applicant. Thus Throop evidently suggest the procedure.

Additionally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

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(i.e., size of the device and means for measuring) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to claim 4 and Benjamin, it is the examiner's position that the art is completely analogous because both are dispensers and structurally equivalent. Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., valving apparatus) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period,

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then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin C. Sirmons whose telephone number is 571-272-4965. The examiner can normally be reached on Monday-Friday 6:30-4:00 ALT FRI.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin C. Sirmons
Primary Examiner
Art Unit 3763

Kevin C. Sirmons
2/22/05